

**Remarks**

Reexamination and reconsideration of this application, as amended, is requested. Claims 1, 4 – 14 and 16 – 25 remain in the application and claims 2, 3 and 15 are cancelled.

Applicant believes there is no charge for this response because no new claims have been added.

**Response to the 35 U.S.C. § 103(a) Rejection**

Claims 1, 4, 11-13 were rejected under 35 U.S.C. 102(e) as being anticipated by Nagaoka (US Patent No. 6,791,773 B2). Applicant respectfully submits that rejection has been overcome in view of the above claim amendments and the remarks that follow.

The office action stated that “wherein the portable communication device is adapted to receive the detachable joystick (See Fig. 1, item 8, Col. 8, Lines 29-34), and the detachable joystick provides a user input indicated with a display (See Fig. 4, item 8, Col. 7, Lines 1-15), wherein the detachable joystick is capable of being stored within the portable communication device when not in use (See Fig. 1, items 1, 8).

Applicant has examined FIG 1, items 1 and 8, and in the detailed description FIG. 1 is described as follows:

Example 1 is constructed as shown in the perspective view of FIG. 1, wherein 1 indicates a portable image display body, 2 a viewing unit, 3 a speaker portion, 4 a microphone portion, 5 an antenna portion, 6 a direct-view liquid crystal display unit, 7 a set of push buttons, 8 an operating stick portion, and 21 a signal light for indicating the end of data reception. It is here noted that the end of data reception may also be indicated by sounds.

Applicant submits that the joystick of Nagaoka does not provide that it may be capable of being stored within the device. Indeed, Nagaoka is completely devoid of details on whether or not the joystick is storeable and even if it were, there is no details on how it is. Further, as the joystick is shaped significantly different than the joystick of the present invention, it seems difficult to store in body 1.

Notwithstanding Nagaoka not disclosing the joystick capable of being stored, Applicant has amended claim 1 as follows:

1. (Currently amended) A portable communication device comprising:
  - a display; and
  - a detachable joystick; wherein the portable communication device is adapted to receive the detachable joystick, and the detachable joystick provides a user input indicated with the display, and wherein the detachable joystick is capable of being stored within the portable

communication device when not in use and includes a user depressible button.

Claim 2 has been incorporated into claim 1 which was rejected under 35 U.S.C. 103(a) as being unpatentable over Nagaoka as aforementioned in claims 1, 14, 16 and 19 in view Hoggarth (Pub. No.: US 2002/0057257 A 1 ).

Applicants respectfully submit that the Examiner cannot satisfy the basic requirements of a prima facie case of obviousness by using Nogaoka and Hoggarth to reject the pending independent claims 1. For the Examiner to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the references. Second, there must be some reasonable expectation of success. Finally, the references when combined must teach or suggest all of the claimed limitations. Manual of Patent Examining Procedure, Section 2143. For the reasons articulated below, the Applicants believe that in the present case, the Examiner has not met this burden.

Applicant submits that Nagaoka cannot be properly combined with Hoggarth et al. to teach the present invention. As with Applicant's previous response, taking for granted that the operating stick of Nagaoka is equivalent to the joy stick of the

present invention (please note Applicant does not make this concession but merely accepts this for arguendo), Hoggarth discloses a laptop computer having a display, a matrix of touch-sensitive keys, and a TrackPoint.RTM. device for generating cursor and function selection on display is embedded centrally among the keys. The TrackPoint.RTM. has a removable cap into which the joystick can be mechanically and electrically coupled. This permits stable platform joystick operation, especially where the computer executes programs involving a joystick as an element of a simulated control interface.

Applicant notes the size and shape of the joystick with the depressible button and the impossibility of being stored even within a large laptop computer – much less the device of the present invention. Applicant submits that combining the references would be problematic and improper as the art is dissimilar and the joysticks are of a completely different shape. If one examines the joystick of Nagaoka, it would be difficult to see where you could place a depressible button (especially if it were to be storables in the body).

Further, Applicant notes that focus of Nagaoka is to make a viewing unit of the image display compact so that it can be mounted on portable telephones or information terminals while Hoggarth provides a control post or joystick electromechanically engaging a keypad-centered pointer device for a laptop computer or the like. As the art is dissimilar, there is no suggestion or motivation

to combine the art and indeed it seems that it may be impractical to combine the two, Applicant respectfully submits that the 103 rejection as it relates to claim 2 (which is now integrated into claim 1) and claims that depend therefrom has been traversed.

As independent claims 12 and 21 have been amended to include the limitation of the depressible button that was added to claim 1, for at least the reasons set forth above, Applicant respectfully submits that these independent claims and claims that depend therefrom are in condition for allowance as well.

Conclusion

Applicant believes that the foregoing is a full and complete response to the Office Action mailed 11-15-2005 and it is submitted that claims 1, 4 – 14 and 16 – 25 are in condition for allowance.

Should it be determined that an additional fee is due under 37 CFR §§1.16 or 1.17, or any excess fee has been received, please charge that fee or credit the amount of overcharge to deposit account #02-2666.

If the Examiner believes that there are any informalities which can be corrected by an Examiner's amendment, a telephone call to the undersigned at (503) 439-8778 is respectfully solicited.

Respectfully submitted,

Dated: 1/4/06



Mark C. Van Ness  
Reg. No. 39,865

Blakely, Sokoloff, Taylor & Zafman, LLP  
12400 Wilshire Boulevard  
Seventh Floor  
Los Angeles, CA 90025-1030  
(310) 207-3800